

REMARKS

This responds to the Office Action mailed on April 21, 2008.

Claims 19-25 are amended, claims 1-18 are canceled and claims 26-35 are added; as a result, claims 19-35 are now pending in this application.

Claim Objections

Claims 7 and 9-12 were objected to due to informalities. Claims 7 and 9-12 have been canceled, rendering the objection moot.

§103 Rejection of the Claims

Claims 1, 6, 7, 12, 13 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik (U.S. Patent No. 6,957,259), further in view of DiStefano III (U.S. Patent No. 6,631,400). Claims 1, 6, 7, 12-13 and 18 have been canceled rendering the § 103 rejection moot.

Claims 3-5, 9-11, and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik (U.S. Patent No. 6,957,259) and DiStefano III (U.S. Patent No. 6,631,400), further in view of Kirsch (U.S. Publication No. 2004/0177120A1). Claims 3-5, 9-11 and 15-17 have been canceled rendering the § 103 rejection moot.

Claims 19-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik (U.S. Patent No. 6,957,259), in view of Michael (U.S. Publication No. 2002/0188689A1), further in view of Kirsch (U.S. Publication No. 2004/0177120A1).

The applicable law recites that obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Supreme Court are: determining the scope and content of the prior art; resolving the level of ordinary skill in the pertinent art; and ascertaining the differences between the claimed invention and the prior art.¹

The Federal Circuit has stated that “[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated

¹ Graham v. John Deere Co., 383 U.S. 1 (1966)

reasoning with some rational underpinning to support the legal conclusion of obviousness.”² For the reasons provided below, the Applicants respectfully submit that the cited documents do not support the Office Action’s § 103 rejection.

As noted above, claim 19 has been amended. The limitations of amended claim 19 include the following:

*registering content of the electronic publication based on
computing a signature of the content and associating the
signature with the electronic publication via the publication
ID.*

The Office Action does not allege that any of the cited documents or their combinations describe all of the limitations of amended claim 19. For that reason alone, amended claim 19 overcomes the Office Action’s § 103 rejection. The Applicants explain below at least some of the reasons, the cited documents do not support the legal conclusion of obviousness.

The cited documents do not describe “registering content of the electronic publication” as required by amended claim 19. In its rejection of claim 19, the Office Action alleges that Malik describes registering electronic publications when a postmaster registers his email profile at a server. The cited portion of Malik recites the following:

*The process of registering a source involves identifying the source,
specifying target statistics for the source, and specifying an e-mail profile for e-
mails from the source. This information is gathered from the postmaster,
preferably through a series of interactive screens, and stored in the database.*

(Column 8, lines 4-9)

The Applicants respectfully submit that Malik’s “registering a source” is not the same as “registering content of the electronic publication.” For example, Malik’s

² In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)

“registering a source” relates to identifying a source **based on its “domain name, IP address...”** etc., and regulating an email **based on the source of the email** (Malik, column 8, lines 27-34), which is not the same as “registering **content** of the electronic publication” much less “registering content of the electronic publication **based on computing a signature of the content and associating the signature with the electronic publication via the publication ID.**”

In its rejection of claim 1, the Office Action alleges that DiStefano describes “users opt in based on **registered content...**” (Office Action, page 4, paragraph 7). But DiStefano recites the following:

*Unlike ordinary bulk email lists, however, **the recipients in the opt-in bulk email list can pre-register their preferences to receive marketing material relating to selected topics.***

Thus, in DiStefano, it “the recipients” that are pre-registered and not content that is registered. Accordingly, DiStefano is not shown to describe “registering content of the electronic publication.” What is missing from Malik and DiStefano is not described by Kirsch, Michael or their combinations with Malik and/or DiStefano.

The Applicants respectfully submit that the cited documents do not describe “computing a signature of the content and associating the signature with the electronic publication via the publication ID.” In its rejection of claim 20, the Office Action alleges parenthetically that the Kirsch describes “signature of publication, Kirsch, [0035], [0056], **compute sender identification hash code** and look up” (Office Action, page 8, paragraph 16). Paragraph 0056 of Kirsch includes the following:

In one embodiment, the identification of the true sender can be encoded into a unique hash code; this hash code subsequently could be used to look up...the reputation of the true sender at the central database, which indexes information by the hash code of each true sender.

(Emphasis added)

Since Kirsch merely describes **encoding the identification of the sender** and does not describe “computing a **signature of the content**,” Kirsch fails to describe what amended claim 19 requires. Further, using the hash code to look up a **reputation** is not the same as “**associating the signature** with the **electronic publication** via the **publication ID**.”

What is missing from Kirsch is not described by Malik, DiStefano and/or Michael or their combinations.

For the reasons explained above, the Applicants respectfully submit that amended claim 19 overcomes the Office Action’s § 103 rejection. Claims 20-22 depend from claim 19 and overcome the rejection for at least the same reasons.

The limitations of claim 23 include the following:

*assigning a publication identification (ID) to the publication and
associating the publication ID with a signature of the content;*

and

*sending the publication ID to the client based on determining that
the content is associated with the publication, the publication
ID allowing the client to determine that the electronic
publication is included in a subscribed list stored on the client,
and to move the content to a client inbox.*

The Office Action does not allege that any of the cited documents or their combinations describe what amended claim 23 requires. Accordingly, the Office Action does not provide an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The Applicants respectfully remind the Office that a combination of cited elements must capture the synergy between the claimed features and cannot merely do no more than they would in separate, sequential operation. For the

reasons explained above, the Applicants respectfully submit that amended claim 23 and its dependent claims 24-25 are allowable over the Office Action.

New Claims

Claims 26 and 30 are new.

The limitations of claim 26 include “registering the content by associating the content with the publication, via the publication ID,” which is substantially similar to the limitations of amended claim 19 described above. The Applicants respectfully submit that claim 26 and its dependent claims 27-29 are allowable at least for the reasons described above with respect to amended claim 19.

The limitations of claim 30 include the following:

A method for managing an inbox on a client machine, the method comprising:
receiving from a content publisher, content included in a publication;
querying a server to determine whether the content is registered;
in response to the request, receiving a publication identification (ID) identifying
the publication and indicating that the content is registered with the server;
determining that a user is subscribed to the publication based on finding the
publication identified by the publication ID in a subscribed list stored on the
client machine; and
allowing the content to reach the inbox on the client machine based on the
publication being registered and the user being subscribed to the publication.

The Applicants respectfully submit that new claim 30 is allowable over the Office Action at least because the cited references and/or their combinations are not shown to describe “in response to the request, receiving a publication identification (ID) identifying the publication and indicating that the content is registered with the server.” Accordingly, the Applicants respectfully request that new claim 30 be allowed. Claims 31-35 depend from claim 30 and overcome the rejection for at least the same reasons.

Serial Number: 10/663,204

Filing Date: September 15, 2003

Title: METHOD AND APPARATUS TO ENABLE MASS MESSAGE PUBLICATIONS TO REACH A CLIENT EQUIPPED
WITH A FILTER

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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